

### **REMARKS**

By this Response, Applicant has amended claims 1, 47, 51, and 56. Support for the amendments to claims 1, 47, 51, and 56 may be found at least in paragraphs [0026]-[0028] and claim 2 of the originally-filed application. Thus, no new matter has been added by these amendments. Claims 1, 3, 5-9, 11, 12, 16-23, 26-38, 40-53, 55, and 56 are pending in the application for examination on the merits.

In the Office Action,<sup>1</sup> claims 1, 3, 5-7, 9, 11, 12, 16, 18, 19, 47-53, and 56 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over International Patent Application No. WO 99/51815 to Husband et al. ("Husband"). Final Office Action at 2. Claims 1, 3, 5-9, 11, 12, 17, 20-23, 26-36, 38, 40-46, and 55 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over International Patent Application No. WO 00/59840 to Golley et al. ("Golley"). Id. at 6-11.

Claims 1, 21, 38, 47, 51, 55, and 56 are the only independent claims pending in the application. Applicant has amended claims 1, 47, 51, and 56 and respectfully submits that those claims comply with 35 U.S.C. § 102(b) and § 103(a) for at least the reasons outlined herein. Nevertheless, to the extent that the Examiner considers rejecting those claims based on the references of record in the application, Applicant respectfully submits that independent claims 1, 47, 51, and 56, as well as the claims that depend therefrom, are patentably distinguishable from those references, and such claim rejections would be improper for at least the reasons outlined herein. With respect to the rejection of remaining independent claims 21, 38, and 55, Applicant

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<sup>1</sup> Applicant respectfully submits that the final Office Action contains a number of assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicant respectfully declines to automatically subscribe to them.

respectfully traverses the § 103(a) rejection of those claims based on Golley for at least the reasons outlined in more detail herein.

**I. Claim Rejection under § 103(a) based on Husband**

With respect to the rejection of independent claims 1, 47, 51, and 56 based on Husband, Applicant respectfully submits that Husband does not render all of the subject matter recited in each of those independent claims, as well as the claims that depend therefrom, *prima facie* obvious for at least the reasons outlined below. Thus, Applicant respectfully requests reconsideration and withdrawal of the claim rejection.

The rejection statement asserts that Husband “differs from Applicant’s recitations of claims by not disclosing identical ranges (the shape factor range from about 32 to 49). However, ‘about’ permits some tolerance. The reference discloses close ranges, and close ranges have been held to establish *prima facie* obviousness.” Office Action at 3 (internal citation omitted). Applicant respectfully submits that independent claims 1, 47, 51, and 56 each recite ranges higher than the discrete value disclosed in Husband, and thus, those claims are not *prima facie* obvious based on Husband.

Applicant respectfully submits that the claim rejection fails to adhere to the guidance of the M.P.E.P. with respect to obviousness based on assertions of close ranges. According to the M.P.E.P. , although “a *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close,” the M.P.E.P. also advises that the prior art ranges must be “close enough that one skilled in the art would have expected them to have the same properties” as the claimed ranges. See § 2144.05(I) (citation omitted). Further, the M.P.E.P. advises that “[a] *prima facie*

case of obviousness may also be rebutted by showing that the art . . . teaches away from the claimed invention." Id. § 2144.05(III) (citation omitted).

As an initial matter, Applicant notes that although Applicant does not agree with the claim rejections included in the final Office Action, Applicant has amended claims 1, 47, 51, and 56, such that "about" has been deleted from those claims in relation to the lower end of the recited range of shape factors. Thus, the rejection statement's reliance on "'about' permitting some tolerance" has been rendered inapplicable.

In addition, Applicant respectfully submits that one skilled in the art would not have expected the composition disclosed in Husband to have the same properties as the composition, papers, and method recited in independent claims 1, 47, 51, and 56 of the present application, nor does the rejection statement identify any disclosure in the prior art to support such a notion. Indeed, not only does Husband not disclose the range recited in any of independent claims 1, 47, 51, and 56, Husband does not include any express disclosure that would lead one skilled in the art to expect the composition disclosed in Husband to have the same properties as the subject matter recited in independent claims 1, 47, 51, and 56. Thus, while independent claim 1 is directed to a "composition comprising kaolin having a shape factor ranging from 32 to 49," and independent claims 47, 51, and 56 are directed to "kaolin having a shape factor of at least 32," Husband expressly discloses only a single value of shape factor, and that disclosed shape factor is lower than the lower limit of the shape factor ranges recited in Applicant's claims. Indeed, Husband's Composition 4, on which the rejection statement relies for support, discloses "a high quality paper coating-grade kaolin from Georgia, US having . . . a shape factor of 30." Husband at p. 41, ll. 13-23. Regardless of Husband's

teachings of a paper coating-grade kaolin, the shape factor of that kaolin is not within the range recited in the claims. Moreover, there is no express disclosure in Husband that would lead a person skilled in the art to believe that Husband's composition would have the same properties as the properties of the compositions recited in Applicant's independent claims 1, 47, 51, and 56.

For at least the above-outlined reasons, Husband does not disclose or render obvious all of the subject matter recited in each of independent claims 1, 47, 51, and 56. Accordingly, those claims are not *prima facie* obvious under 35 U.S.C. § 103(a) based on Husband. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1, 47, 51, and 56, as well as the rejected claims that depend therefrom, under 35 U.S.C. § 103(a) based on Husband.

## **II. Claim Rejection under § 103(a) based on Golley**

Concerning the rejection of claims 1, 3, 5-9, 11, 12, 17, 20-23, 26-38, 40-46, and 55 under § 103(a) based on Golley, claims 1, 21, 38, and 55 are the only pending independent claims included in that claim rejection. Applicant respectfully traverses the rejection of independent claims 1, 21, 38, and 55, as well as the claims that depend therefrom, because Golley does not render the subject matter recited in each of those claims *prima facie* obvious for at least the reasons outlined below.

The rejection statement asserts that Golley "differs from Applicant's recitations of [the] claims by not disclosing identical ranges (the percentage of the particle size and the shape facto[r] of about 32 to 49). However, the reference discloses 'overlapping' ranges and close ranges ('about' permits some tolerance.) Close and overlapping

ranges have been held to establish *prima facie* obviousness.” Office Action at 6.

Applicant respectfully submits that independent claims 1, 21, 38, and 55 each recite ranges lower than the range disclosed in Golley, and thus, those claims are not *prima facie* obvious based on Golley.

As an initial matter, Applicant notes that independent claims 1, 21, 38, and 55 do not recite “about” in relation to the upper end of the recited range of shape factors. Thus, the rejection statement’s reliance on “‘about’ permitting some tolerance” is inapplicable with respect to Applicant’s recited range of shape factors and Golley’s teaching of shape factors greater than 50.

In particular, independent claim 1 is directed to a composition including, *inter alia*, “kaolin having a shape factor ranging from 32 to 49 . . . [and] an esd of less than about 0.25  $\mu\text{m}$  [that] ranges from 35% to about 60% by weight.” In contrast, Golley discloses kaolin having “a shape factor *greater than 50* to produce even greater ‘platy’ clay.” Abstract (emphasis added). Further, Golley discloses a pigment product where “*less than 35% by weight* of the particles have an esd smaller than 0.25  $\mu\text{m}$ .” Id. (emphasis added). Thus, Golley fails to disclose either (1) a shape factor range that overlaps the shape factor range recited in Applicant’s independent claim 1, or (2) kaolin having an esd of less than about 0.25  $\mu\text{m}$  in a weight percentage that overlaps the range recited in independent claim 1. Thus, independent claim 1 is not *prima facie* obvious based on Golley.

Independent claim 21 is directed to a method of refining kaolin, including, *inter alia*, “classifying [a] kaolin slurry to obtain a kaolin having a shape factor ranging from about 20 to 49 . . . .” Since Golley discloses “a shape factor of greater than 50,” Golley

does not disclose a range of shape factors within or close to the range of shape factors recited in independent claim 21. Indeed, Golley teaches away from shape factors less than 50. Similarly, independent claim 38, also directed to a method of refining kaolin, recites, *inter alia*, "classifying the slurry to a fine fraction wherein . . . the classified kaolin has a shape factor of less than or equal to 49." Thus, Golley does not disclose a range of shape factors within or close to the range of shape factors recited in independent claim 38. Finally, independent claim 55 is directed to a method of making a kaolin slurry, "wherein the kaolin has a shape factor ranging from about 25 to 49 . . . ." Thus, Golley also does not disclose a range of shape factors within or close to the range of shape factors recited in independent claim 55.

For at least these reasons, Golley does not disclose or render obvious all of the subject matter recited in each of independent claims 1, 21, 38, and 55. Accordingly, those claims are not *prima facie* obvious under 35 U.S.C. § 103(a) based on Golley. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 1, 21, 38, and 55, as well as the rejected claims that depend therefrom, under § 103(a) based on Golley.

### III. Conclusion

For at least the above-outlined reasons, Applicant's independent claims 1, 21, 38, 47, 51, 55, and 56 should be allowable. Dependent claims 3, 5-9, 11, 12, 16-20, 22, 23, 26-37, 40-46, 48-50, 52, and 53 depend from a corresponding one of the allowable independent claims. Therefore, the dependent claims should be allowable for at least the same reasons as the corresponding independent claims.

Applicant respectfully requests reconsideration of the application, entry of the amendments included in this Response, withdrawal of the claim rejections, and timely allowance of all of pending claims 1, 3, 5-9, 11, 12, 16-23, 26-38, 40-53, 55, and 56.

If the Examiner believes that a conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicant's undersigned attorney at (404) 653-6559.

Please grant any extensions of time required to enter this Response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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By: 

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